

53
56. The method of claim 5, wherein said step of generating said first control output signal is performed by a first person, and wherein said desired channel select designation is predetermined by a second person.

Remarks

The foregoing amendment supplements the amendment filed August 18, 1994. A second supplemental reissue declaration for execution by the Applicant is submitted herewith. This declaration discusses each claim amended or added in the foregoing amendment in detail, setting forth the precise differences between the new claims and those originally issued in the '947 patent. The Examiner is respectfully referred to that document for comments concerning the amendments.

The supplemental declaration is unsigned, because Applicant has been travelling outside the United States during much of the period for response to the outstanding Office action. However, a signed copy of the declaration will be supplied to the Examiner as soon as possible following Applicant's return.

The Examiner is thanked for her courtesy in extending to Applicant's undersigned representative the opportunity to interview the Examiner for the purpose of discussing the procedural background of this application and a general overview of the claims pending in this application. Such interview took place on December

6, 1994, and is accurately reflected in the Examiner's Interview Summary Record.

As the Examiner is aware, Patent No. 5,068,734 that issued on the parent application to the application for the patent in reissue is involved in litigation. The case is Beery v. Hitachi Home Electronics (America), Inc. et al., Case No. 93 4868 DT (Ex) in the United States District Court for the Central District of California. The patent sought to be reissued, Patent No. 5,045,947, is not involved in that litigation. However, Applicant understands from the Office Action that this reissue application will henceforth be treated by the Patent and Trademark Office as if it was directed to a patent that was itself involved in litigation.

Applicant hereby requests that this application be examined, notwithstanding the litigation.

The current procedural status of the litigation is that in December 1994, the District Court entered summary judgement for defendants based upon a finding of non-infringement. The period for filing a notice of appeal to the United States Court of Appeals for the Federal Circuit has not yet expired.

The Examiner has required that any documents and/or materials related to the litigation that would be material to the examination of this application be made of record in response to this Action.

During the course of the litigation, defendants have raised a number of defenses related to the validity and/or enforceability of the '734 patent. For the purpose of informing the examiner of the nature of such defenses, the following papers from the litigation are being submitted herewith:

1. FIRST AMENDED COMPLAINT FOR PATENT INFRINGEMENT
2. FIRST AMENDED ANSWER OF DEFENDANTS, GEMSTAR DEVELOPMENT CORPORATION, HENRY C. YUEN AND DANIEL S. KWOH, TO PLAINTIFF'S FIRST AMENDED COMPLAINT
3. FIRST AMENDED ANSWER OF HITACHI HOME ELECTRONICS (AMERICA), INC. TO FIRST AMENDED COMPLAINT FOR PATENT INFRINGEMENT

With regard to the defenses raised based upon invalidity in view of prior art, Applicant has already submitted to the Office three Information Disclosure Statements setting forth prior art documents, many of which have been relied upon by defendants in the litigation. However, a further review of the files of both the undersigned and Applicant's trial counsel have identified several additional documents which are being submitted concurrently herewith.

Additionally, in case they are useful to the Examiner, the following papers which relate to the parties' application of references to the patent in litigation, are being submitted:

1. PLAINTIFF JACK BEERY'S RESPONSE TO HENRY C. YUEN'S FORST SET OF REQUESTS FOR ADMISSION (NOS. 1-9)
2. DEFENDANT GEMSTAR DEVELOPMENT CORPORATION'S RESPONSE TO PLAINTIFF'S SECOND SET OF INTERROGATORIES (NOS. 4-10)
3. DEFENDANT GEMSTAR DEVELOPMENT CORPORATION'S RESPONSE TO PLAINTIFF'S FIRST SET OF REQUESTS FOR ADMISSION (NOS. 1-32)
4. DEFENDANT GEMSTAR DEVELOPMENT CORPORATION'S RESPONSE TO PLAINTIFF'S SECOND SET OF REQUESTS FOR ADMISSION (NOS. 33-57)
5. DEFENDANT GEMSTAR DEVELOPMENT CORPORATION'S RESPONSE TO PLAINTIFF'S FOURTH SET OF REQUESTS FOR ADMISSION (NOS. 62-83)
6. DEFENDANT GEMSTAR DEVELOPMENT CORPORATION'S RESPONSE TO PLAINTIFF'S SEVENTH SET OF REQUESTS FOR ADMISSION (NOS. 129-143)
7. DEFENDANT HITACHI HOME ELECTRONICS (AMERICA), INC.'S RESPONSE TO PLAINTIFF'S FIRST SET OF REQUESTS FOR ADMISSION (NOS. 1-26)
8. DEFENDANT HITACHI HOME ELECTRONICS (AMERICA), INC.'S RESPONSE TO PLAINTIFF'S SECOND SET OF REQUESTS FOR ADMISSION (NOS. 27-48)
9. DEFENDANT HITACHI HOME ELECTRONICS (AMERICA), INC.'S RESPONSE TO PLAINTIFF'S THIRD SET OF REQUESTS FOR ADMISSION (NOS. 49-64)
10. DEFENDANT HITACHI HOME ELECTRONICS (AMERICA), INC.'S RESPONSE TO PLAINTIFF'S TENTH SET OF REQUESTS FOR ADMISSION (NOS. 247-261)
11. REPLY TO PLAINTIFF'S OPPOSITION TO DEFENDANTS' MOTION FOR BIFURCATION OF TRIAL AND DISCOVERY OR, IN THE ALTERNATIVE, FOR AN ORDER ESTABLISHING THE SEQUENCE OF DISCOVERY

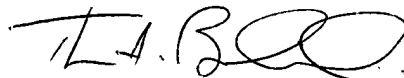
Defenses related to inequitable conduct have also been raised in the litigation, as set forth in the Amended Answers submitted herewith. While various other litigation papers relate to this

issue, such as motions for summary judgement and related documents, these are not being submitted since the Office does not examine reissue applications on this ground, MPEP 1448.

Applicant's undersigned representative has made every effort within the time available for response to this Action to provide for the examiner's review and consideration those papers from the litigation which are material to the examination of this application. However, in view of the large number of papers generated during the litigation, and the fact that the litigation is being handled by other attorneys than the undersigned, Applicant may find it necessary to supplement this response with additional papers which may be later identified.

Reconsideration and allowance of claims 1-56 of the application is hereby respectfully requested.

Respectfully submitted,



Thomas A. Boshinski
Reg. No. 30,611

210 Dapplegate Way
Alpharetta, GA 30202
404-897-4421

January 9, 1995